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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,767	01/10/2002	Mark Andrew Mattox	049322-0104	8331

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3000 K STREET NW
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EXAMINER

CARRILLO, BIBI SHARIDAN

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 08/25/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/044,767

Applicant(s)

MATTOX, MARK ANDREW

Examiner

Sharidan Carrillo

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: of the reasons set forth herein.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-16.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Sharidan Carrillo
Primary Examiner
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Continuation of 2. NOTE: The claims as amended raise 112, second paragraph issues which require further consideration. Additionally, amending the claims to recite "cleaning" instead of "treating" would also require further search and/or consideration..

Advisory Action

1. The 112, second paragraph rejection is maintained in view of the non-entry of the After-Final Amendment.

2. Applicant argues that Chartier et al. do not teach complexing the iron sulfide with the recited composition. Applicant further argues that Chartier et al. teach mechanical action using the claimed composition. Applicant's arguments are unpersuasive since Chartier et al. is performing the same method steps using the same composition as that of the instantly claimed invention. Therefore, the step of complexing the iron sulfide is inherently taught by the teachings of Chartier et al. Further, the instant specification does not specifically define what is meant by complexing the iron sulfide. Additionally, applicant's own specification teaches the use of mechanical means such as pigging.

3. Applicant argues the combination of Odell et al. and Burger. Specifically, applicant argues that there is no teaching of removing iron sulfide from dry gas and oil pipelines. Applicant argues that the composition of Odell et al. is limited to water formations. The examiner agrees that Odell et al. teach using the composition for the treatment of oil wells. However, Odell et al. recognize the problem in the oil industry of fouling by the ferrous sulfide deposits. Additionally, Burger also recognizes the problem of fouling of ferrous sulfide deposits in oil field pipeline systems, which carry water, oil, and natural gas and further recognizes that it is conventional in the art to treat ferrous sulfide deposits by pigging in combination with biocide treatments. Since it is notoriously well known in the art (i.e. Fidoe et al. WO02/081217) that tetrakis hydroxymethyl phosphonium salts are biocides used for solubilizing iron sulfide deposits in the oil industry, and since Burger teaches it is conventional to use biocides for removal of the

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iron sulfide deposits from pipelines, it would have been within the level of the skilled artisan to have applied the composition of Odell et al. to the treatment of gas and oil pipelines.

Additionally, with respect to the dry gas pipeline, applicant's Exhibit I defines dry gas as natural gas and Burger et al. teach oil field pipeline systems containing water, oil and natural gas (col. 2, lines 65-67, col. 1, lines 45-50).

4. Applicant argues that Burger fails to teach applying the biocide treatments to dry gas and oil pipelines. Applicant argues that the method of Burger is limited to an aqueous environment. Applicant's arguments are unpersuasive. Col. 2-3 bridging clearly teaches that in oil field pipeline systems pigging and biocide treatments are used to remove the biofilm from the pipe surface.

5. Applicant argues that there is no motivation to combine the teachings of Odell et al. and Burger. Applicant's arguments are unpersuasive since both references recognize the problem of fouling in the oil industry by the iron sulfide deposits. Further Burger teaches it is conventional in the art to clean pipeline systems with biocides for removal of iron sulfide and Odell et al. teach THP for removal of iron sulfides, wherein the THP are notoriously well known in the art as biocides, as previously discussed above.

6. Applicant argues that Odell et al. is silent to the use of any biocide treatment. Applicant's arguments are unpersuasive since Odell et al. teach using the claimed composition, which is notoriously well known in the art as a biocide.

7. Applicant's arguments filed 8/1/03 have been fully considered but are deemed unpersuasive for the reasons recited above.

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8. In an interview with Mr. Steve Reid on 8/20/03, the examiner suggested amending the independent claims to a composition "consisting of" in order to overcome the prior art rejections. However, no agreement could be reached.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 703-308-1876. The examiner can normally be reached on Monday-Friday, 6:00a.m-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 703-308-4333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Sharidan Carrillo
Primary Examiner
Art Unit 1746

Bsc
August 20, 2003



SHARIDAN CARRILLO
PRIMARY EXAMINER